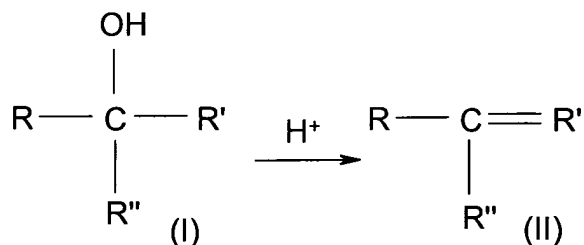


REMARKS

Favorable reconsideration and allowance of the present application is respectfully requested.

Currently, claim 50-85, including independent claims 50, 74, and 79, are pending in the present application. Independent claim 50, for instance, is directed to a breath testing device comprising a visual indicating agent that is color sensitive to at least one odorous compound present in the breath of a user. The visual indicating agent has the following general formula (I) or (II):



R is (CH₃)₂NC₆H₅, (NH₂)C₆H₅, or C₆H₅;

R' is (CH₃)₂NC₆H₅, (NH₂)C₆H₅, C₁₀H₆(OH), or (NaCO₂)C₁₀H₅(OH); and

R'' is H, (CH₃)₂NC₆H₅, (NH₂)C₆H₅, C₁₀H₆O, or (NaCO₂)C₁₀H₅O.

The present inventors have discovered that, through use of the specific type of visual indicating agent set forth above, the breath testing device may detect a broad range of odorous compounds (e.g., sulfur and amine compounds) at very low levels (e.g., threshold of 10 ppb). (See e.g., Appl. p. 3).

Previous dependent claim 26 (now cancelled) specified the visual indicating agent having the general formula set forth above. In the recent Office Action, dependent claim 26 was rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Application Publication No. 2001/0056246 to Rodriguez-Fernandez in view of U.S.

Patent Application Publication No. 2003/0082237 to Cha, et al. and further in view of U.S. Patent No. 3,615,478 to Hoshino. Rodriguez-Fernandez is directed to a sensing element for the detection of volatile sulphur compounds in gas samples. The sensing element includes a solid support and a redox calorimetric reagent that is capable of being reduced by volatile sulphur compounds. Examples of such reagents are said to include 5,5'-dithiobis(2-nitrobenzoic acid) and metallic chelate Neucoproin-Cu(II). As correctly noted by the Examiner, however, Rodriguez-Fernandez fails to disclose a visual indicating agent having the formula set forth in independent claim 50.

Nevertheless, Rodriguez-Fernandez was combined with Hoshino in the Office Action in an attempt to render obvious previous claim 26.¹ Hoshino is directed to a light-sensitive photographic material that contains a fixing agent. Among a laundry list of numerous possible color modifiers, Hoshino mentions the use of various dyes, such as michleris hydrol. The Office Action indicated that it would have been obvious to substitute the color modifier of Hoshino for the redox calorimetric reagent of Rodriguez-Fernandez "as it is merely the substitution of one known color indicator for another."

However, the fact that a certain color modifier is merely "known in the art" is not a sufficient basis for establishing a *prima facie* case of obviousness under § 103(a). The appropriate test is instead whether, when viewing the references in their entirety, an objective motivation or suggestion would have existed for one of ordinary skill in the art to substitute the color modifier of Hoshino for the redox calorimetric reagent of Rodriguez-Fernandez. Applicants respectfully submit that no such motivation would

¹ Cha, et al. was also cited for the teaching of nanoparticles. As independent claim 50 does not require nanoparticles, this reference is not specifically addressed herein.

have existed. For example, Hoshino specifically relates to *photographic* materials, while Rodriguez-Fernandez relates to *sulphur sensors*. The functions of these references are so unrelated that one would certainly not seek to employ a photographic color modifier only cursorily mentioned in Hoshino with the sulphur sensor of Rodriguez-Fernandez. In fact, it is submitted that no motivation would have existed at all to modify Rodriguez-Fernandez due to its particular emphasis on the redox calorimetric reagents described therein. Thus, for at least the reasons set forth above, Applicants respectfully submit that the present claims patentably define over the above-cited references.

Previous dependent claim 26 was also rejected in the Office Action under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 3,507,269 to Berry in view of U.S. Patent Application Publication No. 2003/0082237 to Cha, et al. and further in view of U.S. Patent No. 3,615,478 to Hoshino. Berry is directed to a diagnostic device for halitosis. The device contains various indicia sensitized for hydrogen sulfide, sulphur dioxide, succinic acid, pH or hydrogen ion concentration, blood, and agmatine. (Cols. 2-3). However, Berry fails to disclose a visual indicating agent having the formula set forth in independent claim 50. Nevertheless, Hoshino was combined with Berry in an attempt to render obvious previous claim 26.² However, the same reasons noted above with respect to the proposed combination of Hoshino with Rodriguez-Fernandez also apply to the proposed combination of Hoshino with Berry.

Applicants emphasize that the issue in conducting an analysis under 35 U.S.C. § 103(a) is not whether a theoretical re-design of a material is *possible* or that it might be

² Cha, et al. was also cited for the teaching of nanoparticles. As independent claim 50 does not require nanoparticles, this reference is not specifically addressed herein.

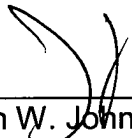
obvious to try the modification. Instead, the issue hinges on whether the claimed invention *as a whole* would have been obvious. In this case, the Office Action appears to have parsed and dissected only certain portions of Hoshino, and then used these dissected portions in a way that would require a substantial reconstruction of Rodriguez-Fernandez or Berry. Clearly, the Office Action is using the present application as a "blueprint" for selectively re-designing the references, which is improper under 35 U.S.C. § 103. Thus, for at least the reasons set forth above, Applicants respectfully submit that one of ordinary skill in the art would not have found it obvious to modify the references in the manner suggested in the Office Action.

It is believed that the present application is in complete condition for allowance and favorable action, therefore, is respectfully requested. Examiner Nasser is invited and encouraged to telephone the undersigned, however, should any issues remain after consideration of this amendment.

Please charge any additional fees required by this Amendment to Deposit Account No. 04-1403.

Respectfully requested,

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